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and no longer include such terms as "very good", "high", "above average", and "adapted". Claims 33, 45, and 46 have been cancelled.

The Examiner states that, "Claims 16 and 35 are indefinite in their recitation of '[t]he maize plant breeding program' since the claims from which they depend are drawn to methods rather than breeding programs. Replacement of the phrase with '[t]he method' would obviate this rejection." Claims 16 and 35 has been so amended and therefore are in condition for allowance.

The Examiner states that, "Claims 19-20 and 48-49 are indefinite in their recitation of '[t]he single gene conversion(s) of claim' since the preceding claims are drawn to maize plants rather than single gene conversions. Replacement of 'conversion(s)' with --conversion--, and insertion of --maize plant -- after 'conversion', would obviate this rejection." Claims 19-20 and 48-49 have been amended as suggested by the Examiner and therefore the claims are in condition for allowance.

The Examiner states that, "Claims 14, 33, 43, and 45-46 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morgan (U.S. 5,824,848)." The Examiner goes on to state, "The claims are drawn to maize plants exhibiting two traits and which are derived from the exemplified maize inbred following an unspecified number of crosses for an unspecified number of generations with other plants of unspecified genetic complements, wherein at least one parent was the exemplified maize plant." Claims 33, 45, and 46 have been cancelled. Claims 14, 42, and 43 have been amended, and now each claim clearly has a limit on the number of crosses away from PH726. Claim 14 has been amended and now reads, "An inbred maize plant, or parts thereof, wherein said inbred maize plant was developed by a cross of the maize plant of claim 2 with a second maize plant, growing a progeny seed obtained from said cross, and repeating the steps of selfing and growing each subsequent generation to obtain said inbred maize plant." Claim 14 is limited to an inbred maize plant one cross away from PH726. Support for this amendment can be found in the specification, for example, on page 3, line 31 through page 4, line 5. Claim 42 has been amended to read, "The method of claim 40, further comprising: (c) crossing said PH726-derived maize plant with itself to yield additional PH726-derived progeny maize seed; (d) growing said progeny maize seed of step (c) under plant growth conditions, to yield additional PH726-derived maize plants; (e) repeating the crossing and growing steps of (c) and (d) to generate further PH726-derived maize plants." Claim 43 now through dependency is limited to one cross away from PH726. For

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clarification, claim 43 has been amended to read, "The further PH726-derived maize plants, or parts thereof, produced by the method of claim 42."

The Examiner goes on to state that "...*In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product by a different process, if the process of making the product fails to distinguish the two products." The Applicant points out that while the processes of breeding, cross-pollinating, growing, and self-pollinating are not unique processes, the use of the unique invention PH726 in the processes makes the processes and the products resulting from those processes unique. The requirement of claims 14 and 43 is that PH726 is used, thus making the processes and their resulting products unique. In light of the amendments and remarks the Applicant requests that the Examiner reconsider his rejection and allow claims 14 and 43.

Examiner rejects claims 1-49 under 35 U.S.C. 103(a) as being unpatentable over Morgan (U.S. 5,824,848).

In the application, the Examiner has noted some similarities in the morphologies inbred maize line PH726 and the Morgan inbred maize line F361: yellow endosperm, dark green leaves, pink anthers, and pendent ears. However, in addition to these similarities, there are also notable differences, as is documented below.

The following table notes some of the differences between inbred maize line PH726 and the maize line F361. This information can be found in Table 1 on pages 18-20 and Tables 2A-2B on pages 38-39 of the specification and in Tables 1, 2, and 3 of the Morgan patent, 5,824,848.

PH726	F361
1,440 heat units from emergence to 50% plants in silk	1,693 to 1,707 heat units from emergence to 50% plants in silk
1,440 heat units from emergence to 50% plants in pollen	1,662 to 1,678 heat units from emergence to 50% plants in pollen
84-85 inches = plant height	74-75 inches = plant height
52.2 cm = tassel length	48.8 = tassel length
Anther color is red	Anther color is pink
Glume color is light green	Glume color is green
Silk color is pink	Silk color is green yellow
Fresh husk color is dark green	Fresh husk color is green
17 cm = ear length	12.4 cm = ear length

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The Applicant respectfully disagrees with the Examiner. Applicant submits that though PH726 and F361 exhibit some similar physiological and morphological traits, PH726 is clearly differentiated from F361. One would not be able to obtain PH726 through modification of the maize inbred taught by Morgan because PH726 comprises a unique and nonobvious combination of genetics. Further, plants derived from PH726 are also clearly differentiated, and are themselves a unique and nonobvious combination of genetics derived from PH726. Thus, they deserve to be considered new and nonobvious compositions in their own right.

In light of the above, Applicant respectfully requests the Examiner reconsider and withdraw the rejection to claims 1-49 under 35 U.S.C. 103(a).


Cancellation of claims 33, 45, and 46 and amendment of claims 1, 3, 5, 6, 14, 16, 19, 20, 21, 22, 24, 25, 35, 37, 40, 41, 42, 43, 48, and 49 does not in any way change the claim scope which the Applicant believes is allowable but is meant to hasten the issuance of the patent.

CONCLUSION

Attached hereto is a marked-up version of the changes made to the specification and claims by current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE".

Applicant submits that in light of the foregoing amendments and the remarks, the claims 1-32, 34-44, and 47-49 are in condition for allowance. Reconsideration and early notice of allowability is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

Respectfully submitted,
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VERSION WITH MARKINGS TO SHOW CHANGES MADE**In the specification**

On page 59, lines 2-21 have been deleted and the clean paragraph as written was inserted.

In the claims

Claims 33, 45, and 46 were deleted.

Claims 1, 3, 5, 6, 14, 16, 19, 20, 21, 22, 24, 25, 35, 37, 40, 41, 42, 43, 48, and 49 were amended as follows:

1. (Amended) Seed of maize inbred line designated PH726, representative seed of said line having been deposited under ATCC Accession No. [] PTA-4437.

3. (Amended) The maize plant of claim 2 [, wherein said plant is male sterile] further comprising a genetic factor conferring male sterility.

5. (Amended) A tissue culture according to claim 4, [the] cells or protoplasts of the tissue culture being from a tissue selected from the group consisting of leaves, pollen, embryos, roots, root tips, anthers, silks, flowers, kernels, ears, cobs, husks, and stalks.

6. (Amended) A maize plant regenerated from the tissue culture of claim 4, capable of expressing all the morphological and physiological characteristics of inbred line PH726, representative seed of which have been deposited under ATCC Accession No. [] PTA-4437.

14. (Amended) [A] An inbred maize plant, or parts thereof, wherein [at least one ancestor of said maize plant is] said inbred maize plant was developed by a cross of the maize plant of claim 2[, said maize plant expressing a combination of at least two PH726 traits selected from the group consisting of: a relative maturity of approximately 110 based on the Comparative Relative Maturity Rating System for harvest moisture of grain, high yield, very good drydown, above average cold test scores, very good stay green, above average resistance to root lodging, above average resistance to stalk lodging, above average plant height, very good drought tolerance, and adapted to the Central Corn Belt region of the United States] with a second maize plant, growing a

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progeny seed obtained from said cross, and repeating the steps of selfing and growing each subsequent generation to obtain said inbred maize plant.

16. (Amended) The [maize plant breeding program] method of claim 15 wherein plant breeding techniques are selected from the group consisting of: recurrent selection, backcrossing, pedigree breeding, restriction fragment length polymorphism enhanced selection, genetic marker enhanced selection, and transformation.

19. (Amended) The single gene [conversion(s)] conversion maize plant of claim 18, wherein the gene is a dominant allele.

20. (Amended) The single gene [conversion(s)] conversion maize plant of claim 18, wherein the gene is a recessive allele.

21. (Amended) A maize plant, or parts thereof, having all the physiological and morphological characteristics of inbred line PH726, representative seed of said line having been deposited under ATCC accession No. [_____] PTA-4437.

22. (Amended) The maize plant of claim 21 [, wherein said plant is male sterile] further comprising a genetic factor conferring male sterility.

24. (Amended) A tissue culture according to claim 23, [the] cells or protoplasts of the tissue culture being from a tissue selected from the group consisting of leaves, pollen, embryos, roots, root tips, anthers, silks, flowers, kernels, ears, cobs, husks, and stalks.

25. (Amended) A maize plant regenerated from the tissue culture of claim 23, capable of expressing all the morphological and physiological characteristics of inbred line PH726, representative seed of which have been deposited under ATCC Accession No. [_____] PTA-4437.

35. (Amended) The [maize plant breeding program] method of claim 34 wherein plant breeding techniques are selected from the group consisting of: recurrent selection, backcrossing, pedigree breeding, restriction fragment length polymorphism enhanced selection, genetic marker enhanced selection, and transformation.

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37. (Amended) A process for producing inbred PH726, representative seed of which have been deposited under ATCC Accession No. [_____] PTA-4437, comprising:

- (a) planting a collection of seed comprising seed of a hybrid, one of whose parents is inbred PH726 said collection also comprising seed of said inbred;
- (b) growing plants from said collection of seed;
- (c) identifying said inbred PH726 plants;
- (d) selecting said inbred PH726 plant; and
- (e) controlling pollination in a manner which preserves the homozygosity of said inbred PH726 plant.

40. (Amended) A method for producing a PH726-derived maize plant, comprising:

- (a) crossing inbred maize line PH726, representative seed of said line having been deposited under ATCC Accession No. [_____] PTA-4437, with a second maize plant to yield progeny maize seed;
- (b) growing said progeny maize seed, under plant growth conditions, to yield said PH726-derived maize plant.

41. (Amended) A PH726-derived maize plant, or parts thereof, produced by the method of claim 40 [, said PH726-derived maize plant expressing a combination of at least two PH726 traits selected from the group consisting of : a relative maturity of approximately 110 based on the Comparative Relative Maturity Rating System for harvest moisture of grain, high yield, very good drydown, above average cold test scores, very good stay green, above average resistance to root lodging, above average resistance to stalk lodging, above average plant height, very good drought tolerance, and adapted to the Central Corn Belt region of the United States].

42. (Amended) The method of claim 40, further comprising:

- (c) crossing said PH726-derived maize plant with itself [or another maize plant] to yield additional PH726-derived progeny maize seed;
- (d) growing said progeny maize seed of step (c) under plant growth conditions, to yield additional PH726-derived maize plants;

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(e) repeating the crossing and growing steps of (c) and (d) [from 0 to 5 times] to generate further PH726-derived maize plants.

43. (Amended) [A] The further [derived maize plant] PH726-derived maize plants, or parts thereof, produced by the method of claim 42.

48. (Amended) The single gene [conversion(s)] conversion maize plant of claim 47, wherein the gene is a dominant allele.

49. (Amended) The single gene [conversion(s)] conversion maize plant of claim 47, wherein the gene is a recessive allele.